

REMARKS

This Amendment is responsive to the Final Office Action mailed July 17, 2006, ("Office Action").

Claim Amendments

Consistent with the specification, claims 9 and 16 have been modified to include the oxidation reactor of FIG. 2 (paragraph 0037).

Claim Rejections – 35 USC § 103

Claims 9-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakagawa et al. (US 6,024,774)("Nakagawa") considered with Clawson (US 6,641,625)("Clawson").

Nakagawa is relied on by the Office as teaching an apparatus for selectively reducing carbon monoxide content of a hydrogen rich gas, comprising: a catalyst bed containing an oxidation catalyst; a porous tube positioned substantially within a catalyst bed for distributing raw material gas throughout the catalyst bed; and a cooling jacket for maintaining the reactor temperature; and the porous tube is an alumina tube.

First, Applicants believe that Nakagawa is not a proper 35 U.S.C. 103 reference as it is not analogous prior art (M.P.E.P. 2141.01(a)). According to the M.P.E.P., while "PTO classification is some evidence of analogy, . . . similarities and differences in structure and function carry more weight" (M.P.E.P. 2141.01(a)). The Nakagawa invention and the present invention involve different fields of endeavor (M.P.E.P. 2141.01(a)). The object of the Nakagawa invention is to provide a chemical reaction apparatus capable of enhancing the generation rate for the main product gas by removing carbon dioxide as a byproduct gas out of the reaction system (Col. 1, lines 43-46). In contrast, as demonstrated throughout the specification, the present invention is generally directed to an apparatus for

selectively reducing carbon monoxide content of a hydrogen rich gas (0011, lines 1-3; 0038, lines 1-5; 0039, lines 1-4).

Second, the preamble of independent claims 9 and 16 contain the following expression: "for selectively reducing the carbon monoxide content of a hydrogen rich gas." The Examiner has not considered this expression solely because it appears in the preamble (Office Action, p. 4). However, according to the M.P.E.P., "[t]he determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts of each case" (M.P.E.P. 2111.02). "The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Coming Glass Works v. Sumitomo Elec. U.S.A. Inc.*, 868 F.2d 1251, 9 U.S.P.Q. 2d 1962, 1966 (Fed. Cir. 1989). Based on the contents of the office actions, the Examiner has not performed this case-by-case analysis of the preamble. An examination of the specification of the present invention clearly reveals that the expression "for selectively reducing the carbon monoxide content of a hydrogen rich gas" in the preamble of independent claims 9 and 16 is not mere introductory language. See *In re Stencel*, 828 F.2d 751, 754, 4 U.S.P.Q. 2d 1071, 1073 (Fed. Cir. 1987). Rather, the language was clearly intended to represent an additional structural limitation. Throughout the specification, the invention is only discussed relative to "selectively reducing the carbon monoxide content of a hydrogen rich gas." "[W]hen the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." *Bell Communications Research v. Vitalink Communications Corp.*, 55 F.3d 615, 34 U.S.P.Q. 2d 1816, 1820 (Fed. Cir. 1995) (emphasis in original). Further, [i]f the claim preamble, when read in the context of the entire claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 U.S.P.Q.2d 1161, 1165-66 (Fed. Cir. 1999) (M.P.E.P. 2111.02).

In the present invention, *both* the preamble and the body of claims 9 and 16 define the subject matter of the invention.

Third, consistent with the specification, claims 9 and 16 have been modified to include the oxidation reactor of FIG. 2 (paragraph 0037). A review of Nakagawa reveals that an oxidation reactor is not disclosed in Nakagawa.

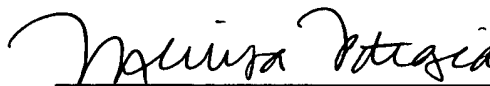
In conclusion, for the reasons set forth above, independent claims 9 and 16, as well as the claims which depend from them directly or indirectly, are not unpatentable over Nakagawa. Reconsideration and withdrawal of the rejection is respectfully requested.

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Applicants respectfully request reconsideration of the obviousness rejection. This is believed to be a full and complete response to the outstanding Office Action mailed July 17, 2006. The present application is believed to be in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of the captioned application is respectfully requested.

Respectfully submitted,



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